

REMARKS

I. Status of Claims

Claim 27 is currently pending. In this amendment, non-elected claims 28-30 and 32-114 have been canceled without prejudice or disclaimer pursuant to the subject matter claimed therein. Therefore, new matter has not been added by this Amendment.

II. Restriction Requirement

The Office finalized the restriction requirement between Groups I, II, III, and IV. Office Action at page 2-4. According to the Office, Groups I-IV fall into different sub-classifications and require different searches. *Id.* at 3. According to the Office, because the compounds are generically recited as (A) and (B) encompassing a large number of compounds, there would be a serious burden to conduct a search of all compounds and combinations recited in these groups. *Id.*

Although Applicant disagrees with the merits of this rejection, in order to advance prosecution of this application, Applicant canceled the non-elected claims without prejudice or disclaimer of any subject matter and requests that the full scope of the remaining pending claim, i.e., claim 27, be examined in this application.

III. Rejection under 35 U.S.C. § 103

The Office now rejects claim 27 under 35 U.S.C. § 103 as being unpatentable over Bhatt (U.S. Patent No. 6,106,808) in view of Ramin (U.S. Patent No. 5,683,681). Office Action at page 5. Applicant respectfully disagrees and traverses the rejection for the following reasons.

According to the Office, Bhatt teaches administering a composition of (1) a polyurethane resin, namely a polycondensate of polyoxyethylene diol, diethylene glycol, dimethylopropionic acid and methylene bis-cyclohexy-4-4'-diisocyanate, and (2) at least one film-forming polymer, specifically Gantrez A425. Office Action at page 5. The Office further asserts that this composition is taught in Bhatt as having spray particle sizes of about 20 to 150 microns. *Id.* As stated by the Office, Bhatt does not teach a spray composition with an average diameter less than or equal to 80 microns nor does Bhatt "specifically teach that the composition administered therein comprises a film-forming polymer in addition to the polyurethane." *Id.* Instead, the Office asserts that Gantrez A425 is known in the art as a film-forming polymer, as evidenced by the disclosure in the secondary reference, Ramin. *Id.* Moreover, according to the Office, because the particle size recited in the present invention overlaps the average particle size taught in Bhatt, there is an expectation of success in imparting good hair setting and achieving a natural feel to the sprayed hair. *Id.* at 6.

In order to establish a prima facie case of obviousness, three requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (8th ed. Rev. 1, 2004). In this rejection, the combination of Bhatt and Ramin fails to teach all the

claimed elements. In addition, there is no expectation of success in the provided combination.

Bhatt and Ramin fail to teach all the claim elements. Bhatt highlights that an important aspect of the invention is the viscosity of the composition. Bhatt at Col. 6, ll. 9-11. According to Bhatt, the viscosity of a 55% by weight volatile organic compound ("VOC") composition is about 1 to about 10 cps or about 1 to 25 cps for an 80% by weight VOC composition exhibiting excellent spray-ability. *Id.* at Col. 6, ll. 9-14. In fact, with this viscosity, the spray particle size ranges from about 20 to about 150 microns. *Id.* at Col. 6, ll. 14-16. As such, Bhatt directly links the viscosity with the spray particle size. In fact, Bhatt's disclosure at Col. 5, ll. 9-15 where the spray particle size is provided says nothing about the inclusion of the optional second hair fixative resin, which the Office alleges to correspond with the at least one film-forming polymer of the claimed invention. In addition, in none of Bhatt's examples directed to hair spray composition is a particle size provided. See Bhatt at col. 14, line 35-Col. 27, line 55. "If a reference's disclosed range is so broad as to encompass a very large number of possible distinct compositions, this might present a situation analogous to the obviousness of a species when the prior art broadly discloses a genus." M.P.E.P. § 2144.05 (I); *see also In re Baird*, 16 F.3d 380, 382, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994) (finding no suggestion of variables that would give rise to the selection and thus, does not render obvious Applicants' invention).

Bhatt links viscosity and particle size with no mention of a dispensing device. Therefore, this reference fails to teach or suggest the claimed invention, which includes

“a dispenser device.” In fact, Bhatt merely provides that “the *composition* can be applied to *the hair as a pump spray*.” Bhatt at Col. 4, lines 48 and 49; see also, Col. 13, ll. 29-32 (emphases added). At best, Bhatt merely describes the form of a hair composition, i.e., an aerosol or non-aerosol composition. Ramin is directed to nail compositions and does not remedy the deficiencies in Bhatt. Unlike the prior art, the claimed invention recites “a dispensing device.”

If the Office is relying on knowledge of one of ordinary skill in the art, then that knowledge needs to be made of record. *In re Lee*, 277 F.3d 1338, 1345, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002) (“when they [the Patent Office] rel[ies] on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.”).

In addition, the Office provides an expectation of success based on “imparting good hair setting retention and achieving a natural feel to the sprayed hair, as taught by Bhatt et al. (Col. 4, lines 3-18).” Office Action at page 6. Bhatt, however, attributes these beneficial properties to the inclusion of “carboxylated polyurethane resins.” Bhatt at Col. 4, ll. 10-12. Bhatt does not suggest or teach that these beneficial properties are from “a pump spray or aerosol container in a particle size less than or equal to 80 microns” as argued by the Office in the Office Action at page 6. Thus, the Office fails to provide an expectation of success as required to establish a *prima facie* case of

obviousness. Accordingly, for this additional reason, Applicant respectfully requests the withdrawal of the rejection.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

/Louis Troilo/

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By: _____
Louis M. Troilo
Reg. No. 45,284